UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,018	12/12/2003	Matthew Kenneth Gracie	56704.000109	2322

27682   7590   12/19/2006
HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
RIVERFRONT PLAZA, EAST TOWER
951 EAST BYRD ST.
RICHMOND, VA 23219-4074

EXAMINER
TARAE, CATHERINE MICHELLE

ART UNIT	•	PAPER NUMBER
3623		

MAIL DATE	DELIVERY MODE
12/19/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

<table>
<tr>
<td rowspan="2">Office Action Summary</td>
<td>Application No.
10/735,018</td>
<td>Applicant(s)
GRACIE ET AL.</td>
</tr>
<tr>
<td>Examiner
C. Michelle Tarae</td>
<td>Art Unit
3623</td>
</tr>
</table>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>21 September 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1 and 3-53</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1 and 3-53</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

September 21, 2006 has been entered.

   Claims 1, 6, 16, 29, 40 and 50 have been amended. Claim 2 has been canceled.

Claims 1 and 3-53 are now pending in this application.

Response to Amendments

2.   Applicant's amendments to claims 1, 6, 16, 29, 40 and 50 are acknowledged.

Applicant's cancellation of claim 2 is acknowledged.

Response to Arguments

3.   Applicant's arguments are moot in view of the new grounds of rejection provided

below.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 1, 3-4, 6-53 are rejected under 35 U.S.C. 102(a,e) as being anticipated by

Nagan et al. (U.S. 2003/0126049).

As per claim 1, Nagan et al. discloses a computer-implemented method of

compiling a customer information set that complies with regulatory criteria, the method

comprising:

providing an overall question set having a plurality of questions (paragraphs 30

and 70; A set of targeted questions is used, where the responses enable risk

assessment.);

determining from the overall question set a basic question set, wherein each

question of the basic question set is associated with an expected answer and wherein

the basic question set comprises the minimum number of sequenced questions the

answers to which would be sufficient to meet the regulatory criteria if no unexpected

answers are given (paragraphs 65 and 75; The basic question set includes initial, or a

minimum number of, questions whose responses are needed to adequately assess a level of risk.);

providing criteria for supplementing the basic question set with additional questions from the overall question set within the sequence of the basic question set, based on receiving an answer that differs from the expected answer, wherein the criteria are structured to minimize the number of remaining questions that must be answered in order to comply with the regulatory criteria (paragraphs 58, 65 and 76; Some questions trigger additional questions to the basic question set, such as additional questions beginning with "if yes" or "if no" to the previous question. The remaining questions that must be answered are minimized depending on previous answers.); and

conducting an optimized interactive customer survey with a customer using the overall question set, the basic question set, the expected answer and the criteria for supplementing the basic question set, wherein the basic question set is supplemented according to the criteria each time an answer is received that differs from the expected answer, and returning to the sequence of the basic question set once the supplemental additional questions from the overall question set are completed (paragraphs 27, 72, 75-76; The system asks the questions to customers via an interactive electronic survey. As discussed above, if unexpected answers are provided to a question, then the initial set of questions branches to additional questions such as those that begin with "if yes" or "if no" to the previous question. Likewise, certain responses will also bypass the asking of certain questions, thereby minimizing the questions asked.).

As per claim 3, Nagan et al. discloses a method according to claim 1, wherein the action of conducting an optimized interactive customer survey includes:

displaying to a user the at least one question of the basic question set (paragraph 70); receiving from the user an answer to the at least one question of the basic question set (paragraph 72); determining whether the received answer differs from the expected answer associated with the at least one question of the basic question set (58, 65, 75-76); responsive to a determination that the answer differs from the expected answer associated with the at least one question of the basic question set, establishing an updated question set using the overall question set, the basic question set and the criteria for modifying the basic question set (58, 65, 75-76); and displaying to the user at least one question from the updated question set (paragraphs 58, 65, 75-76; See page 26, question 3, which is only answered by the user if they answered "yes" to question 2, thereby adding questions to the initial question set based on an unexpected answer.).

As per claim 4, Nagan et al. discloses a method according to claim 1, further comprising:

constructing a customer information set using answers received during the optimized interactive customer survey and storing the customer information set (paragraphs 53 and 71; Customer answers are received and stored and used to develop historical customer data.).

As per claim 6, Nagan et al. discloses a method according to claim 1 further comprising:

associating an anticipated answer set with at least one of the plurality of supplemental additional questions, the anticipated answer set comprising at least one anticipated answer (paragraphs 58, 65, 75-76; See page 26, question 3, which is only answered by the user if they answered "yes" to question 2, thereby adding questions to the initial question set based on an unexpected answer. The supplemental additional questions have associated anticipated answers.); and

responsive to receiving during the optimized interactive customer survey an answer to the at least one of the plurality of supplemental additional questions that matches one of the at least one anticipated answer, determining a risk contribution factor to be associated with the received answer (paragraphs 52 and 74; Each response to each question has an assigned scores which contribute to the overall risk factor.).

As per claim 7, Nagan et al. discloses a method according to claim 6 wherein the risk contribution factor is determined from a predetermined risk contribution factor value associated with the at least one anticipated answer (paragraphs 46-47; Anticipated answers have predetermined risk contribution factor values.).

As per claim 8, Nagan et al. discloses a method according to claim 7 wherein the risk contribution factor is determined based on a risk factor calculation that uses a first predetermined risk factor value, the first predetermined risk factor value being associated with the at least one anticipated answer (paragraphs 46-47, 65-66; Anticipated answers have predetermined risk contribution factor values. Total risk factors are calculated by adding the risk contribution factor values of each response submitted by the customer.).

As per claim 9, Nagan et al. discloses a method according to claim 8 wherein the risk factor calculation also uses a second predetermined risk factor value, the second predetermined risk factor value being associated with a second anticipated answer that has been matched by a received answer (paragraphs 46-47, 65-66; Anticipated answers have predetermined risk contribution factor values. Total risk factors are calculated by adding the risk contribution factor values of each response submitted by the customer.).

As per claim 10, Nagan et al. discloses a method according to claim 1 further comprising:

associating an anticipated answer set with at least one of the plurality of questions, the anticipated answer set comprising at least one anticipated answer (paragraphs 58, 65, 75-76; See page 26, question 3, which is only answered by the user if they answered "yes" to question 2, thereby adding questions to the initial question set based on an unexpected answer. The supplemental additional questions have associated anticipated answers.); and

responsive to receiving during the optimized interactive customer survey an answer to the at least one of the plurality of questions that matches one of the at least one anticipated answer, determining an aggregate risk value (paragraphs 46-47, 65-66; Anticipated answers have predetermined risk contribution factor values. Total risk factors are calculated by adding the risk contribution factor values of each response submitted by the customer.).

As per claim 11, Nagan et al. discloses a method according to claim 10 wherein the risk contribution factor is determined from a predetermined risk contribution factor value associated with the at least one anticipated answer (paragraphs 46-47, 65-66).

As per claim 12, Nagan et al. discloses a method according to claim 11 wherein the risk contribution factor is determined based on a risk factor calculation that uses a first predetermined risk factor value, the first predetermined risk factor value being associated with the at least one anticipated answer (paragraphs 46-47, 65-66).

As per claim 13, Nagan et al. discloses a method according to claim 12 wherein the risk factor calculation also uses a second predetermined risk factor value, the second predetermined risk factor value being associated with a second anticipated answer that has been matched by a received answer (paragraphs 46-47, 65-66).

As per claim 14, Nagan et al. discloses a method according to claim 1, wherein the action of conducting an optimized interactive customer survey is carried out as part of a front-end customer identification procedure (paragraphs 25 and 30).

Claims 16-53 recite substantially similar subject matter to claims 1, 3-4, 6-14 above. Therefore, claims 16-53 are rejected on the same basis as claims 1, 3-4, 6-14 above.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Nagan et al. (U.S. 2003/0126049).

As per claim 5, Nagan et al. discloses a method according to claim 1, wherein

the basic question set includes a plurality of questions from the overall question set and

wherein the action of conducting an optimized interactive customer survey includes:

displaying a first display question set consisting of a plurality of questions from

the basic question set including at least one question having an associated answer;

receiving from the user an answer to the at least one question having an associated

expected answer; determining whether the received answer differs from the expected

answer associated with the at least one question having an associated expected

answer; and responsive to a determination that the answer differs from the expected

answer, establishing an updated question set using the overall question set, the basic

question set and the criteria for modifying the basic question set and displaying a

question set consisting of a plurality of questions from the updated question set

(paragraphs 58, 65, 75-76; See page 26, question 3, which is only answered by the

user if they answered "yes" to question 2, thereby adding questions to the initial

question set based on an unexpected answer.).

Nagan et al. does not expressly disclose displaying a *second* question set that is different from the first displayed question set; rather, Nagan et al. has the overall question set on one display and based on answers to questions, may require the user to answer additional questions already displayed, thereby modifying the basic question set required of the user to answer (paragraphs 58, 65, 75-76; See page 26, question 3, which is only answered by the user if they answered "yes" to question 2, thereby adding questions to the initial question set based on an unexpected answer.). It is old and well known in the art of interactive interfaces to dynamically alter contents of the interface to facilitate the interactivity of the interface. Thus, altering an initial displayed question set so that a second question set is displayed is one such example of dynamically altering contents of an interactive interface. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Nagan et al. to have the displayed question set change based on answers to previous questions as doing so facilitates the input of responses to the questions by indicating to the user exactly what questions must be answered, thereby enhancing the ease of use of the interactive survey.

As per claim 15, Nagan et al. discloses a method according to claim 1 further comprising:

determining for at least one basic question set whether an answer to the at least one basic question set may be determined from non-customer-supplied information (paragraph 73; An authorized agent (i.e., non-customer) may provide the answers to the questions on behalf of the customer.). However, Nagan et al. does not expressly

disclose responsive to a determination that an answer to the at least one basic question set may be determined from non-customer-supplied information, removing the at least one basic question set from the basic question set. However, it is old and well known in the art of customer surveys to not ask a customer a question that has already been answered to avoid repetition and inconveniencing the customer. Therefore, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Nagan et al. to remove a question to be asked of the customer if the answer has already been obtained by a non-customer means as doing so enhances convenience of taking the survey for the user as the user has less questions to answer.

Conclusion

8.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Iliff (U.S. 6,270,456) discusses a medical diagnostic device that uses a script to ask a sequence of questions;

- Lawrence (U.S. 2002/0138408) discusses an automated account risk management system;

- Altman et al. (U.S. 5,572,421) discusses a portable medical questionnaire;

- Osborne et al. (U.S. 6,589,055) discusses an interactive employee training system;

- San Miguel (U.S. 2003/0101086) discusses a decision tree software system; and

- Barton et al. (U.S. 2002/0059093) discusses a system for compliance program assessment.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Tarae whose telephone number is 571-272-6727. The examiner can normally be reached Monday – Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 571-272-6729.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

C. Michelle Tarae
Patent Examiner
Art Unit 3623

December 8, 2006